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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,214	07/17/2006	Jennifer Jane Gordon	CB60684	2772
20462 7590 11/12/2008 SMITHKLINE BEECHAM CORPORATION CORPORATE INTELLECTUAL PROPERTY-US, UW2220 P. O. BOX 1539 KING OF PRUSSIA, PA 19406-0939				
EXAMINER				
SUTTON, DARRYL C				
ART UNIT		PAPER NUMBER		
1612				
NOTIFICATION DATE		DELIVERY MODE		
11/12/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

US\_cipkop@gsk.com

**Advisory Action  
Before the Filing of an Appeal Brief**

<b>Application No.</b> 10/586,214	<b>Applicant(s)</b> GORDON ET AL.
<b>Examiner</b> DARRYL C. SUTTON	<b>Art Unit</b> 1612

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 03 October 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.  
NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-4, 6, 9 and 10  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

/Frederick Krass/  
Supervisory Patent Examiner, Art Unit 1612

/Darryl C Sutton/  
Examiner, Art Unit 1612

Continuation of 11, does NOT place the application in condition for allowance because: Applicant argues that Prosize does not fall within the scope of a composition comprised of 5 to 30% of a film forming component. The Examiner disagrees. As cited in the Final Rejection, Prosize teaches a anhydrous tooth whitening composition comprised of ethanol, PVP-hydrogen peroxide complex, ethylcellulose and optionally with glycerol and/or hydroxypropylmethylcellulose. Prosize teaches an embodiment of the composition comprised of each of the components which has a overall weight percentage of 7.9% of film forming agents, i.e. ethylcellulose and hydroxypropylmethyl cellulose [0017]. Since hydroxypropylmethyl cellulose is only an optional ingredient, it would be obvious to optimize the amount of ethylcellulose in the absence of that component. It would have been obvious to use the value of 7.9% by weight as a starting point of the optimization since the two film forming agents were present in the invention in that combined amount. Therefore, the instant invention is realized through routine experimentation by varying the amount of ethylcellulose. Applicant argues that the composition of Prosize is not dried in-situ and, although the film is flexible and malleable, it generally maintains its integrity throughout the bleaching process; and therefore it differs from the instant invention. The Examiner disagrees, the ability of the composition to dry in-situ is a function which is dependent on the composition of the film. Although the Prosize does not teach that the film dries in-situ, since the compositions are substantially the same, it would be reasonable to expect the composition of Prosize to dry in-situ also. Furthermore, the term "consisting essentially of" limits the scope of the claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristics of the claimed invention. See MPEP 2111.03. Since the hydroxypropylmethylcellulose of Prosize et al. is optional, it is reasonable to consider that it does not materially affect the basic or novel characteristics of the invention, and therefore, the composition of Prosize reads on the composition of the instant application and would possess the characteristics of the instant composition. Applicant argues that since the composition of claim 1 is not obvious over Prosize, one of ordinary skill would not have been motivated to modify the method of Prosize. The Examiner disagrees. The answer to Applicant's argument about Prosize are discussed above. Since the composition of Prosize is a whitening composition, it would be obvious to modify the method of administration to that of Diasti et al., an art recognized method of applying whitening compositions, and to optimize the effectiveness of the composition to whiten by routine experimentation by varying the administration schedule as cited in the Final Rejection.